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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,459	10/29/2003	Taro Suzuki	YTO-004	4579
20374 7590 08/01/2008 KUBOVCIK & KUBOVCIK SUITE 1105 1215 SOUTH CLARK STREET ARLINGTON, VA 22202				
EXAMINER				
SCHLIENTZ, LEAH H				
ART UNIT		PAPER NUMBER		
1618				
MAIL DATE		DELIVERY MODE		
08/01/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/695,459

**Applicant(s)**

SUZUKI ET AL.

**Examiner**

Leah Schlientz

**Art Unit**

1618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 36 and 37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 36 and 37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/23/2008 has been entered.

### ***Inventorship***

In view of the papers filed 12/21/2007, the inventorship in this nonprovisional application has been changed by the deletion of Yoji Fujimori.

The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of Office records to reflect the inventorship as corrected.

### ***Status of Claims***

Claims 11-13 and 35 have been cancelled. Claims 36 and 37 have been amended.

### ***Response to Arguments***

Applicant's arguments, see page 6 of the Response, with respect to the rejection of claims 11 and 35 under 35 USC 102(b) as being anticipated by US 6,117,440, have been considered. The rejection has been WITHDRAWN as being overcome by claim cancellation.

Applicant's arguments, see page 6 of the Response, with respect to the rejection of claims 11 - 13 under 35 USC 102(e) as being anticipated by US 2004/0198625, have been considered. The rejection has been WITHDRAWN as being overcome by claim cancellation.

Applicant's arguments, see page 6 of the Response, with respect to the rejection of claims 11 and 35 under 35 USC 102(e) as being anticipated by Woodfolk et al, have been considered. The rejection has been WITHDRAWN as being overcome by claim cancellation.

Applicant's arguments, see pages 6 – 7 of the Response, with respect to the rejection of claims 11 – 13 and 35 – 37 under 35 USC 102(b) as being anticipated by JP 59-100715 have been considered but are moot in view of new ground(s) of rejection necessitated by changes in the scope of the amended claims.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 36 and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Hikada *et al.* (JP 59-100715).

Hikada teaches synthetic fibers containing poly(p-vinylphenol). The fibers have lasting antimicrobial action. The fibers are useful for socks, underwear and carpet (abstract and page 67).

Accordingly, Hikada practices the claimed active method steps (i.e. **supplying at least one compound** selected from an aromatic hydroxyl compound having in a linear polymer a substituent represented by formula 1 (Applicant's elected species poly-4-vinyl phenol) **in an object**), and thus must inherently accomplish the same method.

Regarding the phrase "where the reactivity of the acarian allergens to specific antibodies is to be inhibited by denaturing or adsorbing the acarian allergens," such a phrase is interpreted to be the equivalent to a "wherein" or "whereby" clause, see MPEP 2111.04. Claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure. However, examples of claim language, although not exhaustive, that may raise a question as to the limiting effect of the language in a claim are: (A) "adapted to" or "adapted for" clauses; (B) "wherein" clauses; and (C)

"whereby" clauses. The determination of whether each of these clauses is a limitation in a claim depends on the specific facts of the case. In *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005), the court held that when a "whereby" clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention." *Id.* However, the court noted (quoting *Minton v. Nat'l Ass'n of Securities Dealers, Inc.*, 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003)) that a **"whereby clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited."** *Id.*

In the instant case, the phrase "where the reactivity of the acarian allergens to specific antibodies is to be inhibited by denaturing or adsorbing the acarian allergens" simply expresses the intended result of the active method step (i.e. **supplying the compound in an object**). Since Hikada practices the claimed method step by incorporating the compound into carpet fiber (i.e. an environment where acarian species are capable of residing), then Hikada would inherently inhibit acarian allergen, whether or not such a result was specifically stated by Hikada. "Products of identical chemical composition cannot have mutually exclusive properties." A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure or composition as that which is claimed, the properties applicant discloses and/or claims are necessarily present. See *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). The "discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's

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functioning, does not render the old composition patentably new to the discoverer." See *Atlas Power Co. v. Ireco Inc.*, 51 USPQ 2d 1943, 1947 (Fed. Cir. 1999). Therefore, merely claiming a new use, new function, or new property, which is inherently present in the prior art does not make the claim patentable. See *In re Best*, 195 USPQ 430, 433 (CCPA 1977), and MPEP § 2112.

Claims 36 and 37 are rejected under 35 U.S.C. 102(a) as being anticipated by Fujimori *et al.* (JP 2003081842, abstract).

Fujimori discloses a wipe sheet for reducing allergens such as house dust mite, pollen and arthropod such as Arachnida acarina in tatami-mat, carpet, furniture, baby article, curtain, wallpaper, etc. The wipe comprises an aromatic hydroxyl compound of formula 1 and polymerizes or copolymerizes the monomer and/or monovalent phenol group (see abstract). Regarding the instantly claimed limitation "where the reactivity of the acarian allergens to specific antibodies is to be inhibited by denaturing or adsorbing the acarian allergens," it is noted that the Fujimori abstract does not specifically recite that acaricidal activity is achieved via denaturation or adsorption, however, such activity would inherently occur upon since the same potential allergens (dust mite) are exposed to the same compound (aromatic hydroxyl compound of formula 1 in a polymer). See MPEP 2112. "[T]he discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer." *Atlas Powder Co. v.*

*Ireco Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977).

The following references drawn to a non-elected species were found during the search for the elected compound. It should not be interpreted that a comprehensive search was performed for all non-elected species.

Claims 36 and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Tougi *et al.* (JP 2000281511).

Tougi discloses an acaricide comprising polyoxyethylene lauryl sulfate. The acaricide is preferably used as a spray (see abstract). Regarding the instantly claimed limitation "where the reactivity of the acarian allergens to specific antibodies is to be inhibited by denaturing or adsorbing the acarian allergens," it is noted that Tougi does not specifically recite that acaricidal activity is achieved via denaturation or adsorption, however, such activity would inherently occur upon application of the spray disclosed by Tougi. See MPEP 2112. "[T]he discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer." *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Thus the claiming of a new use, new function or unknown property which is inherently present in



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the prior art does not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977).

Claims 36 and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Hertlein *et al.* (WO 02056687, whereby US 2002/0169147 is relied upon as equivalent).

Hertlein discloses compositions for controlling pests. The compositions are employed for the control of arthropods, especially of mites and cockroaches. There is a need for measures to control arthropods and allergens. Allergens are generally controlled by denaturing them. The compositions include combinations of components selected from at least two, preferably from three, of groups a, b and c, wherein group b is a surfactant such as sodium lauryl sulphate (abstract; paragraphs 0005 - 0009).

### ***Conclusion***

No claims are allowed at this time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leah Schlientz whose telephone number is 571-272-9928. The examiner can normally be reached on Monday - Friday 8 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hartley can be reached on 571-272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael G. Hartley/  
Supervisory Patent Examiner, Art Unit 1618

LHS